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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,916	10/24/2001	Christian Boehnke	HHI-032US	3006

959 7590 07/06/2004

LAHIVE & COCKFIELD, LLP.
28 STATE STREET
BOSTON, MA 02109

EXAMINER	
LIN, KUANG Y	

ART UNIT	PAPER NUMBER
1725	

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/889,916	BOEHNKE, CHRISTIAN	
	Examiner	Art Unit	
	Kuang Y. Lin	1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum et al. or WO 91/1,910 and further in view of Lemelson.

Each of the primary references substantially shows the invention as claimed except the step of reinforcement adding step. However, Lemelson shows that that it is conventional to add reinforcement material into molten metal during a composite making step. It would have been obvious to add reinforcements material into the molten metal of the primary reference if a composite article is designated. With respect to claim 3, it would have been obvious to add reinforcement material into molten magnesium if a magnesium metal matrix composite is designated.

3. Claims 1-10 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson and further in view of either Blum et al. or WO 91/12,910.

Lemelson substantially shows the invention as claimed except the means for dividing the strand into pellets. However, each of the secondary references shows to provide dividing means in a continuous casting apparatus for forming grooves along the casting strand and thus divides the strand along the grooves to obtain pellets. It would have been obvious

to provide the dividing means of the secondary references in the continuous casting apparatus of Lemelson if pellets are to be obtained from the strand. With respect to claim 3, it would have been obvious to add reinforcement material into molten magnesium if a magnesium metal matrix composite is designated.

4. Applicant's arguments filed June 14, 2004 have been fully considered but they are not persuasive.

5. In page 3 of the remarks applicant stated that one of ordinary skill in the art would not look to Blum for producing light metal composite pellets since Blum uses electron beam gun to melt very high melting temperature material. However, since Lemelson teach to casting light metal composite (see, col. 4, line 1 and col. 7, line 45) it would have been obvious to use the apparatus of Blum for casting the light metal composite of Lemelson if the light metal composite is designated. Applicant failed to view the prior art teaching as a whole, i.e. failed to view both teachings of Blum and Lemelson as a whole and thus the argument is moot.

6. In page 4, 3rd paragraph of the remarks applicant stated that there is no suggestion to combine the teachings of Lemelson and WO '910. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary

skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lemelson teach to use twin belt caster (see col. 7, line 9+) for casting light metal composite, such as aluminum composite (see col.4, line 1 and col. 7, line 45). WO '910 teaches that the continuous cast strand from the conventional twin belt caster is subsequently fed into other apparatus for mechanical working, or **cutting** and/or welding. Thus, in view of the prior art teaching as a whole it would have been obvious to provide the dividing means of the WO '910 in the continuous casting apparatus of Lemelson for obtain pellets from the strand without using additional cutting means as did conventionally.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuang Y. Lin whose telephone number is

571-272-1179. The examiner can normally be reached on Monday-Friday, 10:00-6:30,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas X Dunn can be reached on 571-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kuang Y. Lin
Primary Examiner
Art Unit 1725

7-1-04